

→ M.Y.

50097 US N P



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,842	02/27/2002	Jonas Grina	1392/2/2	2780

22847 7590 06/17/2004

SYNGENTA BIOTECHNOLOGY, INC.

PATENT DEPARTMENT

3054 CORNWALLIS ROAD

P.O. BOX 12257

RESEARCH TRIANGLE PARK, NC 27709-2257

EXAMINER

RAO, DEEPAK R

ART UNIT

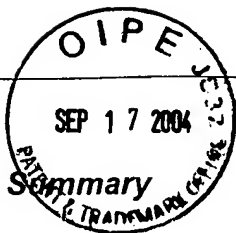
PAPER NUMBER

1624

DATE MAILED: 06/17/2004

Final OA due: September 17, 2004

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

10/083,842

Applicant(s)

GRINA, JONAS

Examiner

Deepak R Rao

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5-8 and 11-13 are allowed.
- 6) ☒ Claim(s) 3,4,9,10 and 14 are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office action is in response to the amendment filed on March 22, 2004.

Claims 1-28 are pending in this application.



### *Election/Restrictions*

Claims 15-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on September 5, 2003. A complete reply to the final rejection must include cancelation of nonelected claims.

### *The following rejections are withdrawn:*

The rejection under 35 U.S.C. 102(b) of the previous office action is hereby withdrawn in view of the amendments.

As the rejection based on prior art of the previous office action has been overcome, the search and examination is expanded to other compounds of the elected Group I.

### *The following rejections are maintained and/or necessitated by the amendment:*

Claims 3-4 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. Claim 3 recites the limitation "one of R2 and R3 further is substituted with a substituent forming a cyclic structure on adjacent atoms of the aromatic ring" in lines 1-3. There is

Art Unit: 1624

insufficient antecedent basis for this limitation in claim 1 on which claim 3 is dependent.

The substituent list provided for the aromatic rings of R2 and R3 in claim 1 does not include any group to fit in the above recitation.

2. Claim 4 recites the limitation "wherein the substituent is selected from the group consisting of 1,2-methylenedioxy and 1,2-difluoromethylenedioxy" in lines 1-3. There is insufficient antecedent basis for this limitation in claim 1 on which claim 4 is dependent (via claim 3). The substituent list provided for the aromatic rings of R2 and R3 in claim 1 does not include any group to fit in the above recitation.

The above reasons were provided in the previous office action. Applicant amended claim 3 by inserting 'further', however, as indicated in the previous office action, claim 1 does not provide for any groups as 'substituents' on the aromatic rings defined under R2 and R3 that together form a cyclic structure with the adjacent atoms. Particularly, claim 1 does not provide groups such as 1,2-methylenedioxy in the substituent list of R2 and R3, and therefore, does not provide proper antecedent basis for these claims.

***The following rejections are necessitated by the amendment:***

Claims 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. Claim 9 recites the limitation "wherein R3 and R4 and O together form a cyclic structure" in lines 1-2. There is insufficient antecedent basis for this limitation in claim 8 which in turn depends from claim 1.

2. Claim 10 recites compounds having a cyclic lactone group, there is insufficient antecedent basis for these compounds in claims 8 and claim 1 on which claim 10 is dependent.

***Allowable Subject Matter***

Claims 1-2, 5-8 and 11-13 are allowed. The references of record do not teach or fairly suggest the claimed compounds.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

June 12, 2004